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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,515	12/07/2000	Joseph C. Eder	8600-0008	2423

23419 7590 07/22/2003

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PALO ALTO, CA 94306

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 07/22/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/733,515

Applicant(s)

EDER ET AL.

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/14/03 has been entered.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,5,6,10 are rejected under 35 U.S.C. 102(e) as being anticipated by Camrud et al. (6258117). Figs. 1A,1B,2A,2B and 8A,8B illustrate a stent or coil that has a plurality of *detachment junctions* of which are separated by resorption of the junction material or breaking. The "intended use recitation"/"functional language" of **junction is cleavable by the application of a different wavelength of electromagnetic radiation** carries no weight in the absence of any distinguishing structure. Camrud clearly discloses the structure as claimed and is found to be inherently capable of performing the function.

Claims 1-7,10,11,13,15,16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (6086599). Lee discloses that the device can be a stent, coil, etc. of which is released from a catheter via a delivery mechanism, col. 1, lines 19-24. Lee also discloses to use a shape memory polymer (col. 3, lines 11-15) and the plurality of *detachment* members can be detached using electromagnetic radiation, such as light or fluid (col. 3, lines 24-31). The "intended use recitation"/"functional language" of **junction is cleavable by the application of a different wavelength of electromagnetic radiation** carries no weight in the absence of any distinguishing structure. Lee clearly discloses the structure as claimed and is found to be inherently capable of performing the function.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. '599. Lee is explained supra. However, Lee does not disclose the light used is visible or non-visible. It would have been an obvious matter of design choice to modify the type of light used, since applicant has not disclosed that using visible light or non-visible light provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any light taught by Lee et al. or the

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claimed types of light in claims 8 and 9 because both light variations perform the same function of providing radiation to separate the junctions.

Claims 12, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. '599 in view of Maitland et al. (6102917). Lee is explained supra. However, Lee does not disclose a transmitting device in the form of fiber optic cables or laser as the light source. Maitland et al. teach that laser energy via an optical fiber can be applied to an SMP to release an object from a catheter system, col. 2, lines 59-65. It would have been obvious to one of ordinary skill in the art to use laser light to provide radiant energy as taught by Maitland in the system of Lee in order to separate the detachment members such that when the junction is cleaved energy is removed.

### ***Response to Arguments***

Applicant's arguments filed 5/14/03 have been fully considered but they are not persuasive. In response to applicant's argument that neither Camrud nor Lee discloses implantable devices that perform Applicant's intended use limitation, please note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable of performing the intended use*, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). There is no structure for the functional language "cleavable by a

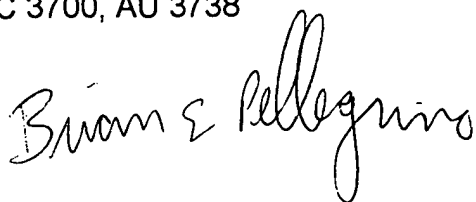
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different wavelength ...." or intended use limitation to be given any patentable weight, see *In re Fuller*, 1929 C.D. 172: 388 O.G. 279 and *In re Mason*, 114 USPQ 127 (CCPA1957). Because Applicants have not distinguished any **structural** difference between the prior art implantable devices and that of the claimed invention, the prior art can be said to anticipate the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 9am to 6:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino  
July 18, 2003  
TC 3700, AU 3738

A handwritten signature in cursive script that reads "Brian E. Pellegrino". The signature is written in dark ink and is positioned below the typed name and date.